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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/632,808      | 08/04/2000  | Lawrence A. Denny    | 1950.006            | 2511             |

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EXAMINER

FRENEL, VANEL

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3626

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/632,808

Applicant(s)

DENNY, LAWRENCE A.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8/4/00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.

**DETAILED ACTION**

***Notice to Applicant***

**1.     *This communication is in response to the application filed August 2000.***

***Claims 1-3 are pending.***

***Claim Rejections - 35 USC § 103***

2.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.     Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyer et al (6,202,923) in view of Kobylevsky et al (6,493,427).

(A)    As per claim 1, Boyer discloses a method for permitting a pharmacist to verify a refill of a filled prescription stored on a host system, comprising the steps of: providing a prescription refill screen by the host system to a pharmacy system associated with the pharmacist, the prescription refill screen being associated with the filled prescription (Col.5, lines 8-67 to Col.6, line 32);

receiving refill request information from the pharmacy system, the refill request information identifying a requested refill of the filled prescription (Col.6, lines 5-67); transmitting the refill request information through the host system to a health care provider system associated with a health care provider identified by the filled prescription stored on the host system (Col.6, lines 1-67).

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Boyer does not explicitly disclose receiving, by the host system, an authorization from the health care provider system authorizing the requested refill of the filled prescription;

transmitting, by the host system, the authorization to the pharmacy system whereby the pharmacist associated with the pharmacy system is authorized to provide the refill of the filled prescription to the patient.

However, these features are known in the art, as evidenced by Kobylevsky. In particular, Kobylevsky suggests receiving, by the host system, an authorization from the health care provider system authorizing the requested refill of the filled prescription; transmitting, by the host system, the authorization to the pharmacy system whereby the pharmacist associated with the pharmacy system is authorized to provide the refill of the filled prescription to the patient (Col.7, lines 10-67 to Col.8, line 34 and Col.29, lines 9-17).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kobylevsky within the Boyer's system with the motivation of providing the prescription which is authorized to be refilled.

(B) As per claim 2, Boyer discloses a method for permitting a pharmacist to verify a refill of a filled prescription stored on a host system, comprising the steps of:

providing a prescription refill screen by the host system to a pharmacy system associated with the pharmacist, the prescription refill screen being associated with the filled prescription (Col.5, lines 8-67 to Col.6, line 32);

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receiving refill request information from the pharmacy system, the refill request information identifying a requested refill of the filled prescription, and a prescription refill authorization obtained from a health care provider (Col.6, lines 5-67).

Boyer does not explicitly disclose generating a verification of the requested refill by the host system including a unique prescription identification code identifying the requested refill whereby the pharmacist associated with the pharmacy system is authorized to provide the refill of the filled prescription to the patient.

However, this feature is known in the art, as evidenced by Kobylevsky. In particular, Kobylevsky suggests a verification of the requested refill by the host system including a unique prescription identification code identifying the requested refill whereby the pharmacist associated with the pharmacy system is authorized to provide the refill of the filled prescription to the patient (See Kobylevsky Col.7, lines 1-67 to Col.8, line 34 and Col.29, lines 9-17).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kobylevsky within the Boyer's system with the motivation of providing the prescription which is authorized to be refilled.

(C) As per claim 3, Boyer discloses a method for permitting a health care provider to verify a refill of a filled prescription stored on a host system, comprising the steps of: providing a prescription refill screen by the host system to a health care provider system associated with the health care provider, the prescription refill screen being associated with the filled prescription (Col.5, lines 8-67 to Col.6, line 32);

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receiving refill request information from the health care provider, the refill request information identifying a requested refill of the filled prescription, and a prescription refill authorization (Col.6, lines 5-67).

Boyer does not explicitly disclose generating a verification of the requested refill by the host system including a unique prescription identification code identifying the requested refill whereby a pharmacist associated with a pharmacy system is authorized to provide the refill of the filled prescription to the patient .

However, this feature is known in the art, as evidenced by Kobylevsky. In particular, Kobylevsky suggests a verification of the requested refill by the host system including a unique prescription identification code identifying the requested refill whereby the pharmacist associated with the pharmacy system is authorized to provide the refill of the filled prescription to the patient (See Kobylevsky Col.7, lines 1-67 to Col.8, line 34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kobylevsky within the Boyer's system with the motivation of providing the prescription which is authorized to be refilled.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches method and apparatus for integrated management of pharmaceutical and healthcare services (6,112,182), on-line pharmacy automated refill system (5,970,462), interactive medication ordering system (5,758,095) and automated method for filling rug prescriptions (5,883,370).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F  
V.F

January 10, 2003

*Alexander Walinowski*  
ALEXANDER WALINOWSKI  
PATENT EXAMINER  
Art Unit 3626